



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/823,527

04/13/2004

Tetsuhiko Keneaki

MAT-8535US

4865

23122 7590 11/17/2008
RATNERPRESTIA
P.O. BOX 980
VALLEY FORGE, PA 19482

EXAMINER

UBER, NATHAN C

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

11/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/823,527	Applicant(s) KENEAKI, TETSUHIKO	
	Examiner NATHAN C. UBER	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>13 April 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on 08 April 2008.
2. Claims 4-7, 9-11 and 13-16 have been amended.
3. Claims 17 and 18 have been added.
4. Claims 1-3 have been canceled.
5. Claims 4-18 are currently pending and have been examined.

Information Disclosure Statement

6. The Information Disclosure Statement filed on 13 April 2004 has been fully considered. An updated initialed copy of the Form 1449 is enclosed herewith.

Drawings

7. The drawings were objected to as failing to comply with 37 CFR 1.84(p)(5) because they included reference characters not mentioned in the description. Applicant's addressed this objection by amendment to the specification. The objection is withdrawn.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
9. Claims 3-16 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 is cancelled so the rejection with regard to claim 3 is moot. Applicant's addressed this rejection by amendment to claims 4, 5 and 9 to remove the indefinite terminology. The rejections are therefore withdrawn.

Claim Rejections - 35 USC § 101

10. Claims 15 and 16 are rejected under 35 U.S.C. 101 because the claims were directed to non-statutory subject matter. The rejections are withdrawn.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 4-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker et al. (US 6,138,106).

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim 4:

Walker, as shown, discloses the following system limitations:

- *a display unit for* (see at least column 4, line 4, video display, monitor),
- *displaying a screen used for inputting data* (see at least column 4, line 6, interface),
- *data required for issuance of a gift certificate* (see at least column 6, lines 54-56, any necessary data such as the value of the gift certificate),

Art Unit: 3622

- *the data comprising a using condition that specifies whether the gift certificate may be redeemed for an item selected by a redeemer of the gift certificate (see at least column 9, lines 25-27, "the product descriptors are used to inform the redeemer of products available for purchase with the gift certificate code...", see also at least columns 10 and 11, lines 67 and 1-4 respectively, buyer may add limitations on the use of the gift certificate),*
- *an input unit for inputting data based on the screen displayed by the display unit (see at least column 4, lines 4-5, keyboard),*
- *a storage unit for (see at least column 4, line 36, database),*
- *storing the data inputted into the input unit in association with a specific code and payment method (see at least column 4, lines 36-38, storing the inputted data),*
- *an issuing unit for issuing the gift certificate (see at least column 6, line 65, generating a gift code/certificate and opening a corresponding record of the gift certificate, and see at least column 7, lines 56-58, transmitting the gift code/certificate electronically or in hardcopy),*
- *comprising the specific code without an indication of a face value of the gift certificate (see at least column 2, lines 32-33, conceal the monetary value of the gift certificate from the recipient, see also at least column 5, lines 26-27 and 31-32).*

Claim 5:

Walker, as shown, discloses the following system limitations:

- *a database that stores payment information (see at least column 5, line 19, a database the stores and retrieves the payment method).*

Claim 6:

Walker, as shown, discloses the following system limitations:

- *the data includes a password input in using the gift certificate (see at least column 7, lines 3-5).*

Claim 17:

Art Unit: 3622

- *the data further includes the payment method of the gift certificate (see at least column 4, lines 64-65, charge a credit card at time of issuance of the gift certificate or at the time of redemption of the gift certificate).*

Claim 7:

Walker, as shown, discloses the following system limitation:

- *the storage unit stores the specific code (see at least column 5, line 19-21).*

Claim 8:

Walker, as shown, discloses the following system limitation:

- *the issuing unit enters a using condition in the gift certificate (see at least columns 10 and 11, lines 66, 67 and 1-10).*

Claim 9:

Walker, as shown, discloses the following system limitations:

- *display unit for (see at least column 4, line 4, video display, monitor),*
- *displaying a screen used for inputting data (see at least column 4, line 6, interface),*
- *data required for use of a gift certificate (see at least column 6, lines 54-56, any necessary data such as the value of the gift certificate),*
- *the data comprising a using condition that specifies whether the gift certificate may be redeemed for an item selected by a redeemer of the gift certificate (see at least column 9, lines 25-27, "the product descriptors are used to inform the redeemer of products available for purchase with the gift certificate code...", see also at least columns 10 and 11, lines 67 and 1-4 respectively, buyer may add limitations on the use of the gift certificate),*
- *an input unit for inputting the data based on the screen displayed by the display unit (see at least column 4, lines 4-5, keyboard),*
- *a storage unit for (see at least column 4, line 36, database),*
- *storing the data inputted into the input unit (see at least column 4, lines 36-38, storing the inputted data),*

Art Unit: 3622

- *a paying unit for* (see at least Figure 2, the certificate redemption program of the central controller),
- *executing a comparison using the using condition stored in the storage unit* (see at least column 4, lines 24-26, central controller gathers and arranges data based on input and stored data, see also at least column 7, lines 30-32, payment method is stored and retrieved from the database),
- *and then executing a predetermined processing based on a result of the comparison* (see at least column 7, lines 60-62, "the costs associated with the use of the gift certificate codes are charged to the buyer after the use of the certificate code(s)").

Claim 10:

Walker, as shown, discloses the following system limitations:

- *the data includes a password* (see at least column 7, lines 3-5).

Claim 18:

- *the data further includes at least one of a specific code entered in the gift certificate and information about a desired commodity* (see at least columns 10 and 11, lines 67 and 1-4 respectively, buyer may add limitations on the use of the gift certificate).

Claim 11:

Walker, as shown, discloses the following system limitation:

- *the data is displayed in a question form on the second display unit* (see at least column 7, lines 3-5).

Claim 12:

Walker, as shown, discloses the following system limitations:

- *the processing executed by the paying unit includes at least one of a predetermined paying processing* (see at least column 4, lines 34 and 35, connected to a credit card processing network),
- *an invalidating processing of the gift certificate* (see at least column 7, lines 45-46).

Claim 13:

Art Unit: 3622

Walker, as shown, discloses the following method limitations:

- *displaying a screen used for inputting data* (see at least column 4, line 6, interface),
- *data required for issuance of a gift certificate* (see at least column 6, lines 54-56, any necessary data such as the value of the gift certificate),
- *the data comprising a using condition that specifies whether the gift certificate may be redeemed for an item selected by a redeemer of the gift certificate* (see at least column 9, lines 25-27, "the product descriptors are used to inform the redeemer of products available for purchase with the gift certificate code...", see also at least columns 10 and 11, lines 67 and 1-4 respectively, buyer may add limitations on the use of the gift certificate),
- *receiving an input of the data displayed on the screen* (see at least column 4, lines 4-5, keyboard),
- *storing the input data in association with a specific code and payment method* (see at least column 4, lines 36-38, storing the inputted data),
- *issuing a gift certificate* (see at least column 6, line 65, generating a gift code/certificate and opening a corresponding record of the gift certificate, and see at least column 7, lines 56-58, transmitting the gift code/certificate electronically or in hardcopy),
- *comprising a specific code without an indication of a face value of the gift certificate* (see at least column 2, lines 32-33, conceal the monetary value of the gift certificate from the recipient).

Claim 14:

Walker, as shown, discloses the following method limitations:

- *displaying a screen used for inputting data* (see at least column 4, line 6, interface),
- *data required for use of a gift certificate* (see at least column 6, lines 54-56, any necessary data such as the value of the gift certificate),

Art Unit: 3622

- *the data comprising a using condition that specifies whether the gift certificate may be redeemed for an item selected by a redeemer of the gift certificate* (see at least column 9, lines 25-27, "the product descriptors are used to inform the redeemer of products available for purchase with the gift certificate code...", see also at least columns 10 and 11, lines 67 and 1-4 respectively, buyer may add limitations on the use of the gift certificate),
- *receiving an input of the data based on the screen* (see at least column 4, lines 4-5, keyboard),
- *storing the input data* (see at least column 4, lines 36-38, storing the inputted data),
- *executing a comparison using the using condition stored in the storage unit* (see at least column 4, lines 24-26, central controller gathers and arranges data based on input and stored data, see also at least column 7, lines 30-32, payment method is stored and retrieved from the database),
- *and then executing a predetermined processing based on a result of the comparison* (see at least column 7, lines 60-62, "the costs associated with the use of the gift certificate codes are charged to the buyer after the use of the certificate code(s)").

Claim 15:

Walker, as shown, discloses the following limitations:

- *displaying a screen used for inputting data* (see at least column 4, line 6, interface),
- *data required for use of a gift certificate* (see at least column 6, lines 54-56, any necessary data such as the value of the gift certificate),
- *the data comprising a using condition that specifies whether the gift certificate may be redeemed for an item selected by a redeemer of the gift certificate* (see at least column 9, lines 25-27, "the product descriptors are used to inform the redeemer of products available for purchase with the gift certificate code...", see also at least columns 10 and 11, lines 67 and 1-4 respectively, buyer may add limitations on the use of the gift certificate),

Art Unit: 3622

- *receiving an input of the data based on the screen* (see at least column 4, lines 4-5, keyboard),
- *storing the input data* (see at least column 4, lines 36-38, storing the inputted data),
- *issuing a gift certificate* (see at least column 6, line 65, generating a gift code/certificate and opening a corresponding record of the gift certificate, and see at least column 7, lines 56-58, transmitting the gift code/certificate electronically or in hardcopy),
- *comprising a specific code without an indication of a face value of the gift certificate* (see at least column 2, lines 32-33, conceal the monetary value of the gift certificate from the recipient).

Claim 16:

Walker, as shown, discloses the following limitations:

- *displaying a screen used for inputting data* (see at least column 4, line 6, interface),
- *data required for use of a gift certificate* (see at least column 6, lines 54-56, any necessary data such as the value of the gift certificate),
- *the data comprising a using condition that specifies whether the gift certificate may be redeemed for an item selected by a redeemer of the gift certificate* (see at least column 9, lines 25-27, "the product descriptors are used to inform the redeemer of products available for purchase with the gift certificate code...", see also at least columns 10 and 11, lines 67 and 1-4 respectively, buyer may add limitations on the use of the gift certificate),
- *receiving an input of the data based on the screen* (see at least column 4, lines 4-5, keyboard),
- *storing the input data* (see at least column 4, lines 36-38, storing the inputted data),
- *executing a comparison using the using condition stored in the storage unit* (see at least column 4, lines 24-26, central controller gathers and arranges data based on

Art Unit: 3622

input and stored data, see also at least column 7, lines 30-32, payment method is stored and retrieved from the database),

- *and then executing a predetermined processing based on a result of the comparison* (see at least column 7, lines 60-62, “the costs associated with the use of the gift certificate codes are charged to the buyer after the use of the certificate code(s)”).

Response to Arguments

13. Applicant's arguments filed 08 April 2008 have been fully considered but they are not persuasive. Applicant argues that “the ‘using condition’ is a limitation on redemption of a gift certificate **for an item already selected by a redeemer**” (see at least page 9 of Applicant's remarks). Applicant contends that this limitation is claimed in the amended claims by the following language “the data comprising a using condition that specifies whether the gift certificate may be redeemed for an item selected by a redeemer of the gift certificate” and that Applicant's interpretation is supported in the specification at page 9, lines 2-10. Examiner disagrees with both of Applicant's contentions as explained below.
14. Applicant contends that the amended claims indicate that “the ‘using condition’ is a limitation on redemption of a gift certificate **for an item already selected by a redeemer**” (see at least page 9 of Applicant's remarks). Examiner does not interpret the claim limitation “the data comprising a using condition that specifies whether the gift certificate may be redeemed for an item selected by a redeemer of the gift certificate” to include any requirement that an item be selected **before** the using condition of the gift certificate is applied because the limitation does not patentably affect the scope of the claim and because the limitation does not specifically require the order of item selection *visa vie* applying the using condition. The limitation occurs in amended claims 4, 9, 13, 14, 15 and 16. Claims 4 and 9 are system claims directed to structural components of the invention and their configurations. The above limitation is incorporated into claims 4 and 9 and serves to limit the content of data that is displayed on a screen used for inputting data required for a gift certificate. Examiner notes that the specific content of the data in this context does not

Art Unit: 3622

patentably affect the scope of the claim. Claims 14-16 are directed to the process of the invention. In these claims the above limitation is incorporated in to the claim and serves to limit the content of data from the step of displaying a screen used for inputting data required for use of a gift certificate. In these claims the only positively recited step is "displaying a screen," therefore the specific content of data that is inputted *using* the screen also fails to patentably affect the scope of the claim.

15. The limitation "the data comprising a using condition that specifies whether the gift certificate may be redeemed for an item selected by a redeemer of the gift certificate" does not specifically require the order of item selection *visa vie* applying the using condition. Examiner has applied the broadest reasonable interpretation of this limitation in light of the specification (see MPEP§ 2111). Although Examiner recognizes that the word *selected* is in the past tense, examiner does not agree that this construction exclusively requires that an item be first selected before a redeemer may be appraised of the using condition. In fact such an interpretation is inconsistent with Applicant's own claim language. For example Applicant clearly indicates the nature of the gift certificate by specifically disclosing in the claims that the gift certificate is issued "without an indication of a face value." There is no corresponding limitation in the claims that requires that the gift certificate is issued without an indication of the using conditions. Contrarily, the specification discloses that the using conditions, including items to be purchased and the store that the gift certificate was issued from, are made known to the redeemer by printing it directly on the gift certificate (see at least page 7 of the specification, lines 7-15). Having applied the broadest reasonable interpretation in light of the specification, Examiner finds that the Walker reference, as cited above, discloses this limitation.
16. Applicant contends that the amended specification supports the interpretation that "the 'using condition' is a limitation on redemption of a gift certificate **for an item already selected by a redeemer**" (see at least page 9 of Applicant's remarks). Applicant's citation is part of a discussion in the specification starting on page 8 differentiating two redemption processes, one in which the redeemer enters the gift certificate into the system herself (see apt least page 8, line 5) and one

Art Unit: 3622

in which the redeemer goes to a store and a store clerk enters the gift certificate into the system on behalf of the redeemer (see at least page 8, lines 5-7). The cited paragraph explains the flow chart of Figure 4 that depicts the specific process of entering the gift certificate information into a sale terminal, terminal 5, by a store clerk. While this process does disclose scanning or inputting a product selection into the terminal before proceeding with the redemption, this figure and this section of the specification does not specifically disclose, as Applicant contends, that the using condition of the gift certificate is concealed from the redeemer. Such a position is in fact in opposition to page 7, lines 7-15 of the specification which discloses that the using conditions, including items to be purchased and the store that the gift certificate was issued from, are made known to the redeemer by printing it directly on the gift certificate. Further the gift certificate disclosed on page 7, gift certificate 6, is the same gift certificate that is discussed in Applicant's cited section (see at least page 9, line 10).

Conclusion

- 17.** Having fully responded to each of Applicant's arguments, and having updated the previous rejections where necessary due to amendments, the previous rejections are maintained and **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
- 18.** A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3622

19. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.
20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
21. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

P.O. Box 1450, Alexandria, VA 22313-1450

or faxed to **571-273-8300**.

22. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

Randolph Building

401 Dulany Street

Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 3622
13 November 2008

/Arthur Duran/
Primary Examiner, Art Unit 3622